

REMARKS

The Applicants thank the Examiner for the examination to date and respectfully request reconsideration and allowance.

The independent claims are 1, 40, 90, 110, 111, 112, 120, and 123. Each independent claim is amended herein using language from the originally filed claims. Claims 7 and 46 are also amended to include a molecular weight parameter from the filed application (paragraph 95 from published application 2005/0009206). If the Examiner believes that any new matter issues are raised by these amendments, a telephone interview with the undersigned is respectfully requested.

One issue remains: whether the independent claims (and associated dependent claims) comply with the requirements of 35 USC § 112, first paragraph. The Examiner has rejected the independent claims for lack of written description and lack of enablement, and the Applicants traverse both of these rejections, particularly in view of the present amendments. The Applicants firmly believe that sufficient specification support is present so that one skilled in the art can practice an invention in which the tips are treated with one or more hydrophilic compounds which inhibit protein adsorption. Nevertheless, the Applicants seek to advance prosecution in a compact fashion as the Applicants have already overcome 112 and prior art issues raised by the Examiner. The Applicants stand ready to work with the Examiner via an examiner's amendment as needed to bring prosecution to a close.

The Applicants will first address independent claim 1. Independent claim 1 presently recites the use of one or more polyalkylene glycol compounds. Based on the controlling "Wand factors" for enablement, the Applicants believe they comply with enablement standards. Most important, the Applicants provide considerable direction to the public including a working example (Example 1 with use of -Si-PEG) and also provide support text in the specification for other types of polyalkylene glycols including citation to literature. See paragraphs 94-101 in published form of present application 2005/0009206 (e.g., reference to four technical literature

documents including Harder paper in *Journal Physical Chemistry B* and US Patent Nos. 6,103,479; 5,858,801; and 5,039,458). Working example 2 also provides guidance on how a surface material (here a cantilever) can be treated to inhibit protein adsorption. The breadth of the claims are reasonable. The nature of the invention is that surface modifications are known as shown in the cited technical literature at paragraphs 94-101. In view of these and other citations, the Applicants respectfully submit that one skilled in the art can determine without undue experimentation how to practice the claim including determining which polyalkylene glycol compounds can inhibit protein adsorption and improve deposition.

Briefly, the Examiner makes reference to Working Example 2 and to the Applicants prior response filed August 19, 2009 at page 15. The Applicants fail to understand how this supports the Examiner's argument. Example 2 actually shows how one can treat a surface (a cantilever surface) to inhibit protein adsorption as required in claim 1. One skilled in the art can distinguish between the embodiments provided in the filed Examples 1 and 2, particularly in view of the teachings provided in paragraphs 94-101. Also, the Applicants in the prior response merely distinguished prior art references as they were asked to do by the Examiner without comment on present enablement or written description issues.

The Examiner has also offered a written description rejection in parallel with the enablement rejection, but the Applicants believe their position on enablement also applies equally to the written description rejection. Clearly, the Applicants possessed the invention on the filing date. If the Examiner believes that written description provides an issue not covered by the enablement law, the Applicants respectfully request a telephone interview to cut through the issues of enablement versus written description.

Therefore, at least in view of the foregoing, the Applicants respectfully request that the rejections be withdrawn.

Other independent claims are also in compliance with the enablement and written description standards in view of the extensive teachings in the application.

Furthermore, the Applicants traverse the rejections for indefiniteness for claims 7 and 46 but the issue is now moot in view of the present amendments which are offered merely to advance prosecution efficiently. Also, the Examiner made comments about the merits of the priority claims which the Applicants traverse but also believe are not material to the issues at hand.

Finally, rejoinder of withdrawn claims is also requested in view of an allowance. The Examiner is available to review any rejoinder issues which may arise.

CONCLUSION

In sum, the Applicants believe that the present application is now in condition for allowance and thus respectfully request favorable reconsideration.

The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Office is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: May 18, 2010

By: /J. Steven Rutt/

FOLEY & LARDNER LLP
Customer Number: 23533
Telephone: (202) 672-5351
Facsimile: (202) 672-5399

J. Steven Rutt
Bruce Wu
Attorney/Agent for the Applicants
Registration No. 40,153